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REMARKS

Claims 1-25 are currently pending in the subject application. Favorable reconsideration of the subject application is respectfully requested in view of the comments below.

Rejection of Claims 1-25 Under 35 U.S.C. §103(a)

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hays *et al.* (U.S. Patent No. 6,260,004) or Wang *et al.* (U.S. Patent No. 5,566,092), either in view of Emori *et al.* (U.S. Patent No. 5,940,272) and Lakin *et al.* (U.S. Patent No. 4,840,222). Reconsideration and withdrawal of this rejection is respectfully requested for at least the following reasons.

Claims 1, 23, and 24 require a diagnostic module contained within a container and mounted to a dynamoelectric machine. In the Office Action dated April 18, 2002, the Examiner concedes that neither Wang *et al.* nor Hays *et al.* specify that monitoring electronics should be mounted upon industrial equipment (page 1). The Examiner then notes that it is well known to make integral that which was separate. However, "there is also a requirement that the unification or integration involves more than mere mechanical skill." In re Murray, 19 CCPA (Patents) 739, 53 F.2d 541, 11 USPQ 155. Mere mechanical skill would involve taking the monitoring electronics and simply mounting the electronics to the machine. However, as noted by Applicant, doing such would cause thermal damage and environmental contamination to the electronics. Thus, mounting the electronics to the machine also involves determining a solution to protect the monitoring electronics from damage and contamination. It is submitted that determining such a solution requires more than mere mechanical skill.

Further, there is nothing in Wang *et al.* or Hays *et al.* which would have motivated one of ordinary skill in the art to mount monitoring electronics upon industrial equipment. Wang *et al.* is directed to a machine diagnostic system that integrates several different technologies, such as neural networks, expert systems, physical models, and fuzzy logic, to detect possible failure conditions in a physical machine or process. The diagnostic system includes a data acquisition module, a diagnostic technologies module, a machine model module, a database module, a user interface, and a system control module. There is nothing in Wang *et al.* that would have suggested to one of ordinary skill in the art to mount the diagnostic system to the machine. Hays *et al.* is directed to four embodiments of a pump diagnosis apparatus. The four embodiments include: a portable, battery powered field diagnostics apparatus; a field-hardened, remote powered, networked diagnostics apparatus; a diagnostics apparatus with controller; and a diagnostic apparatus with host computer. Thus, because

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Hays *et al.* teaches *portable* diagnostic devices, Hays *et al.* teaches away from mounting machine diagnostic devices to machines.

Further, as there is no teaching, suggestion, or motivation in either Wang *et al.* or Hays *et al.* to mount monitoring electronics upon industrial equipment, there is nothing in Wang *et al.* nor Hays *et al.* which addresses the problem of preventing thermal damage to the electronics. Thus, one of ordinary skill would not have looked to the teachings of Emori *et al.* for a heat sink apparatus. Lakin *et al.* fails to cure the aforementioned deficiencies of Wang *et al.*, Hays *et al.*, and Emori *et al.*

In view of the foregoing reasons, the combination of Hays *et al.* or Wang *et al.*, in view of Emori *et al.* and Lakin *et al.* do not make obvious claims 1, 23, and 24. Claims 2-22 and 25 depend from claim 1. Accordingly, withdrawal of this rejection and allowance of claims 1-25 are respectfully requested.

CONCLUSION

The present application is believed to be condition for allowance in view of the above amendment and comments. A prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

In the event any additional fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,



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